REMARKS

Claims 1-22 are pending in the present application. Claims 1-3, 6-9, 12-15 and 18 have been amended, and Claims 19-22 have been added, herewith. Reconsideration of the pending claims is respectfully requested.

Applicants would initially like to thank the Examiner for taking the time to conduct a telephonic interview on 04/12/2004. While no agreement was reached, Applicants' attorney emphasized how Applicants' invention of billing intervention for network access was different from the teachings of the Moen et al. reference, and that with respect to Claim 2, a person of ordinary skill in the art would not have been motivated to combine the Moen and Suzuki references.

I. 35 U.S.C. § 112, Second Paragraph

The Examiner rejected Claims 7-12 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicants regard as the invention. This rejection is respectfully traversed.

Applicants have amended Claims 7-12 in accordance with the Examiner's suggestion. Therefore the rejection of Claims 7-12 under 35 U.S.C. § 112, second paragraph has been overcome.

II. 35 U.S.C. § 101

The Examiner rejected Claims 1, 2 and 6 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed.

Applicants have amended Claims 1 and 2 to overcome the abstract idea rejection. As Claim 6 depends upon Claim 1, Claim 6 has similarly been amended by the amendment to Claim 1 to overcome the abstract idea rejection. Therefore, the rejection of Claims 1, 2 and 6 under 35 U.S.C. § 101 has been overcome.

III. 35 U.S.C. § 102, Anticipation

The Examiner rejected Claims 1, 3-5, 7, 9-11, 13 and 15-17 under 35 U.S.C. § 102 as being anticipated by Moen et al., U.S. Patent 5,864,604. This rejection is respectfully traversed.

Applicants have amended Claims 1, 7 and 13 to further distinguish the claimed
invention from the teachings of the cited reference. Specifically, Claim 1 (and similarly
for Claims 7 and 13) has been amended to recite that the party associated with the
requested document is charged, *in lieu of* the client who otherwise is charged for their
network access, for subsequent access to the network by the client. Thus, amended
Claim 1 provides a method for billing intervention, where the charges for accessing a
network are intervened such that a requesting user who is otherwise being billed for
network access is able to access the network at the expense of another. In contrast; the
cited reference provides no such billing intervention for network access. Instead, it
merely allows for one party to have limited access to predefined information of another
party without content charge for such information, in that the another party has already
purchased for usage relating to a site address containing the information (Col 3, lines 2-
7). If the one party does not have the unique identifier given to it by the another party in
order to have limited access to the pre-paid, predefined information, the one party is
prohibited access to the information. Thus, (i) the one party can either access the
information at the expense of the another party, or (ii) they are precluded from accessing
the information at all (Col. 3, lines 25-26; Figure 1, block 16; Figure 3, blocks 305 and
311). There is no network access billing intervention, as claimed, where in response to
receiving a request for a document, a party associated with the document is charged, in
lieu of the client who otherwise is charged for their network access, for subsequent
network access of the client. Thus, the amendment to Claim 1 (and similarly for Claims
7 and 13) has overcome the 35 USC 102 rejection.

Applicants initially traverse the rejection of Claims 3-5 for reasons given above
regarding Claim 1 (of which Claims 3-5 depend upon). Further with respect to Claim 3
(and similarly for dependent Claims 4-5), Applicants show that the cited reference does
not teach or suggest the claimed feature that client access to the network is via a wireless
link and the network charges are associated with the wireless link access to the network.
This is in contrast to information content charges as taught by Moen. Thus, Claim 3 is
further shown to not be anticipated by the cited reference.

Applicants initially traverse the rejection of Claims 9-11 for reasons given above
regarding Claim 7 (of which Claims 9-11 depend upon). Applicants further traverse the

rejection of Claim 9 (and similarly for dependent Claims 10 and 11) for similar reasons to those given above regarding Claim 3.

Applicants initially traverse the rejection of Claims 15-17 for reasons given above regarding Claim 13 (of which Claims 15-17 depend upon). Applicants further traverse the rejection of Claim 15 (and similarly for dependent Claims 16 and 17) for similar reasons to those given above regarding Claim 3.

Therefore, the rejection of Claims 1, 3-5, 7, 9-11, 13 and 15-17 under 35 U.S.C. § 102 has been overcome.

IV.   **35 U.S.C. § 103, Obviousness**

The Examiner rejected Claims 2, 6, 8, 12, 14 and 18 under 35 U.S.C. § 103 as being unpatentable over Moen et al., U.S. Patent 5,864,604 in view of Suzuki, U.S. Patent 6,493,763. This rejection is respectfully traversed.

With respect to Claim 2 (and similarly for Claims 8 and 14), such claim has been amended to be in independent form. Applicants show that the cited references used in rejecting such claim have been improperly combined using hindsight analysis. When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. "...absence of such suggestion to combine is dispositive in an obviousness determination". *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 42 USPQ2d 1378 (Fed. Cir. 1997). There is simply no reason or other motivation to combine the references. The cited Moen reference explicitly states that once the end user has accessed the desired information, the session is automatically terminated (Col. 5, lines 12-15; Figure 1, block 18). Thus, there would have been no reason to modify Moen's teachings to include a feature of "*in response to receiving a second request for a second document that is not associated with the party*, discontinuing charging the party for the network activity of the client", as the session is unconditionally automatically terminated after processing the first request. The only plausible reason for such modification comes from Applicants' own patent specification, which is improper hindsight analysis. The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested

the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (emphasis added by Applicants). There is simply no suggestion in the cited references to modify the teachings of Moen in accordance with the claimed invention. Thus, Claim 2 (and similarly for Claims 8 and 14) is shown to have been erroneously rejected under 35 USC 103 using improper hindsight analysis.

Applicants further show that neither cited reference teaches or suggests any type of network access billing intervention. At best, information content billing is paid by another. For example, the Suzuki reference teaches a video-on-demand system known in the cable TV art. If a user agrees to have commercials included with the desired information content, the charges for the information content (i.e. the video-on demand work, per Suzukli Col. 5, lines 24-27) are paid by a sponsor. There is no indication that normal fees for the underlying cable TV network access are waived or otherwise paid by another. Thus, Claim 2 (and similarly for Claims 8 and 14) is further shown to not be obvious in view of the cited references.

In similar fashion, Claim 6 (and similarly for Claims 12 and 18) has been improperly rejected using Applicants' own patent specification as the motivation to combine the references. Because Moen teaches an immediate and unconditional termination of the session, there would have not been any reason or other motivation to modify such teaching to include the claimed feature of "after a pre-determined time interval has elapsed, discontinuing charging the party for the network activity of the client". Thus, Claim 6 (and similarly for Claims 12 and 18) is shown to have been erroneously rejected under 35 USC 103 using improper hindsight analysis.

Applicants further traverse the rejection of Claim 6 (and similarly for Claims 12 and 18) for reasons given above regarding Claim 1 and thus show that there are missing claimed elements not taught or suggested by the cited references. To establish prima facic obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03 (emphasis added by Applicants). *See also*, In re Royka, 490 F.2d 580 (C.C.P.A. 1974). None of the cited references teach or suggest that the party associated with the requested document is charged, *in lieu of* the client who otherwise is charged for their network access, for subsequent access to the network by the

client. Thus, Claim 6 (and similarly for Claims 12 and 18) is further shown to not be obvious in view of the cited references.

Therefore, the rejection of Claims 2, 6, 8, 12, 14 and 18 under 35 U.S.C. § 103 has been overcome.
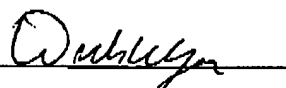
V.   Newly Added Claims 19-22

Applicants have added Claims 19-22 herewith. Examination of such newly added claims is respectfully requested.

VI.   Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: _4 /16/04_

Respectfully submitted,

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